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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,028	04/06/2000	STEPHAN BAUER	48436	8779

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EXAMINER

PAULRAJ, CHRISTOPHER

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 08/19/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	09/529,098	PERRING ET AL.
	Examiner	Art Unit
	Christopher G. Paulraj	1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13-41 is/are pending in the application.
- 4a) Of the above claim(s) 14-18, 20-26, 28-37 and 39-41 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 13, 19, 21, 24, 27 and 38 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 13-41 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> .	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I (claims 13, 19, 21, 24, 27, and 38) in Paper No. 9 is acknowledged. The traversal is on the ground(s) that "whether the person of ordinary skill in this art would or would not choose to use a polymeric binder (adhesive) or a bonding layer is not seen to rise to the level of patentable distinctness. This is a matter of mere choice to the engineer." This is not found persuasive because the standard for determining lack of unity under PCT Rule 13.1 is whether or not the inventions in the different groups contain a single inventive concept, that is whether they share a "special technical feature." In the present claims the groups do not contain a single inventive concept because, they claim different polymeric compositions, which are considered to be the special technical features of the inventions. Contrary to the arguments, the selection of the polymer is not a "matter of mere choice to the engineer," but rather what constitutes the invention itself.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 14-18, 20-26, 28-37, and 39-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1773

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13, 19, 21, 24, 27, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Claims are rejected as prolix when they contain long recitations that the metes and bounds of the claimed subject matter cannot be determined. See MPEP 2173.05(m).

6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 13, component a), recites

Art Unit: 1773

the broad recitation "solid III," and the claim also recites "preferably a basic solid III," which is the narrower statement of the range/limitation.

7. The claims refer to various percentages. However, it is unclear as to what components these percentages are based on. For example in component a), is the 1 to 95 % by weight of solid II based on 100% by weight of the mix Ila or the mixture Ia? Applicants have not clearly specified this for any of the percentages in the claims.

8. The claim, in component b), recites a polymeric composition "obtainable" by polymerization. The phrase "obtainable" is not a positive limitation. It is unclear whether or not the polymer b) needs to be a reaction product of b1) and b2).

9. The term "ore" in component β appears to be a typo. It should be "more."

10. Claim 24 provides for the use of the composite of claim 13, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

11. Claims 19 and 21 refers to a process for producing a product as claimed in claim 13. However, the composite product of claim 13 already limits itself to the manufacture by certain processes (product-by-process). Since the process claims 19 and 21 can be inconsistent with the parent product-by-process claim, they are considered indefinite.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 24 and 38 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 13, 19, 21, 24, 27, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bronsert et al. (WO 97/37397) in view of Koksbang et al. (U.S. Patent 5,340,368) and Williams (U.S. Patent 5,523,118)

WO 97/37937 is written in German. U.S. Patent 6,416,905 is used as an English translation of the WIPO document. Bronsert et al. discloses that the claimed composition for mixture Ia can be used as electrolytes (see abstract). The composition can be used to form a composite electrochemical film having a first layer comprising an electron conducting electrochemical active compound and a second layer comprising

the mixture Ia according to the invention. The first layer and the second layer can be combined by a commonly used coating process (col. 11, lines 60-62).

Bronsert et al. does not specifically disclose that the first and second layers are combined by lamination with heat and pressure or by a corona treatment process. However, these techniques are well known in the art. Koksbang et al. discloses that lamination of electrochemical cells can occur by application of heat and pressure (col. 13, lines 17-18). Williams discloses that corona treatment can be used in the manufacture of electrochemical cells to increase the functionality of a polymer layer to thereby provide better adhesion between the polymer and the other materials coated upon it (col. 6, lines 62-67). One skilled in the art would have found it obvious to employ such process to combine the layers of Bronsert et al. The motivation for doing so would have been to improve the adhesion between these layers.

Information Disclosure Statement

16. Receipt of Information Disclosure Statement filed on August 7, 2000 is acknowledged and has been made of record. Foreign language documents were only considered to the extent of what their English abstracts provided.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher G. Paulraj whose telephone number is (703) 308-1036. The examiner can normally be reached on Monday-Friday, 8am-5pm.

Art Unit: 1773

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (703) 308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.

cgp
August 13, 2002


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700